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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,805	09/26/2000	Scott C. Harris	RTA/SCH	3717

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EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,805

Applicant(s)

HARRIS, SCOTT C.

Examiner

Ryan M Flandro

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,5,7,13-26,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,5,7,13-26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/3/04 has been entered.

Terminal Disclaimer

3. The Terminal Disclaimer submitted 9/3/04 is not proper because the number of the application to which it pertains (i.e., the instant application) has not been identified. Accordingly, the Terminal Disclaimer has been **disapproved**.

Drawings

4. New drawings were received on 5/3/04. These drawings are unacceptable (please see information on how to effect drawing changes set forth below). New corrected drawings are required in this application. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. ***Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet"*** (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Objections

5. Claim 7 is objected to because line 4 includes a typo – the phrase "in a-manner" should be --in a manner--.

Claim Rejections - 35 USC § 112

6. In view of Applicant's Amendment to claim 7, the previous rejection of this claim under 35 USC §112, second paragraph, has been overcome.

Claim Rejections - 35 USC § 103

7. Claims 2, 22, 25, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over eBay¹ in view of Odom.

a. Claim 2 and 22. eBay discloses each and every limitation recited in claim 2, including storing information about an amount that will be required to overcome any current bids on the item, which information is indicative of the amount that will be required to overcome any current bids cannot be viewed by a user of the second computer and which information allows determination of whether an entered bid is higher than a current bid amount. eBay does not, however, teach or disclose that said information is stored at the second computer or that the information allows local determination without contacting said first computer. In eBay the information is stored on the central server and determinations are made once a bid is submitted thereto.

Nevertheless, Odom teaches storing information on the second computer about an amount that will be required to overcome any current bids on the item, which information is indicative of the amount that will be required to overcome any current bids and which information allows local determination at the second computer of whether an entered bid is higher than a current bid amount without contacting said first computer (see column 6

¹ <http://pages.ebay.com/aw/proxy-bidding.html>, viewed February 1999.

lines 28-58 and *especially* lines 31-45). Odom teaches this system such that “unnecessary communications to the server are avoided.”

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to store the aforementioned information on the second computer so that local determinations can be made as to the submitted bid to avoid unnecessary communications with the central server as taught by Odom.

b. Claim 25. eBay discloses each and every limitation recited in claim 25, including on a first computer connected to the internet hosting an internet auction for an item; accepting bids on said at least one item from at least one other computer, connected to said first computer, and displaying a current price for the item on said other computer, and keeping secret a current maximum bid which has been placed for the item from a user of said other computer (“...secret, so no one will know what you maximum bid amount was”). eBay further uses an Internet browser application on the user end in conjunction with software on the server to enable automatic bidding, but does not explicitly disclose displaying an icon on said other computer which allows a bid to be placed without contacting said first computer, wherein said icon enables placing a bid which is high enough to exceed said current maximum bid.

Odom, however, teaches displaying an icon on said other computer 170 (column 8 lines 30-33 – second computer employs a GUI, which is defined as an interface for issuing commands to a computer utilizing a pointing device, as a mouse, that manipulates

and activates graphical images --icons-- on a monitor.²) which allows a bid to be placed without contacting said first computer 100 wherein said icon enables placing a bid which is high enough to exceed a current maximum bid (see column 6 lines 28-55 and *especially* lines 31-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to manually click an icon that will allow a user to bid an amount that exceeds a current maximum bid without contacting said first computer to avoid unnecessary communications with the server and to allow a user to outbid a current maximum amount. Given the teachings of Odom, the bidder in the eBay example could simply click the icon to bid \$8.50 (although the user would not know this amount until after the bid was placed) to outbid Joe's maximum of \$8.00.

c. Claim 26. The combination of eBay and Odom further discloses running an applet (a local application) on said second computer, which includes information enabling determining whether an entered bid is higher than said maximum bid (see column 6 lines 28-55 and *especially* lines 31-45).

d. Claim 28. The combination of eBay and Odom further includes, in said second computer, determining whether an entered bid is higher than said secret maximum bid amount, and informing a user at said second computer without contacting said first computer (see Odom column 6 lines 28-55 and *especially* lines 31-45).

²The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

Art Unit: 3679

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over eBay and Odom, as applied above, in view of Ausubel (US 5,905,975). The combination of eBay and Odom lacks explicit disclosure that said bids include an indication of time and date, and said placing comprises providing bids to an agent program which keeps that amounts of the bids secret until a time of day and date specified by the bid.

Ausubel, however, teaches a method wherein said bids are provided to an agent program (see top of column 3 – “intelligent systems...auctioneer’s system”), which keeps the amounts of the bids secret (see column 1 lines 63-64 “*combining some of the advantageous facets of the sealed-bid format...*”) until a time that is specified by the bid (see generally column 2). This allows users to create a set of rules (which could include bids being placed at specific times) that take place during the auction without action of the user so that the user need not monitor the auction throughout its duration. Furthermore, such rules are not known to other users and are, therefore, secret.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide bids to an agent program which keeps that amounts of the bids secret until a time specified by the bid in order to allow the user to avoid having to constantly monitor the auction as taught by Ausubel.

9. Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over eBay in view of Brown (5,794,219).

- a. Clearly, eBay discloses on a computer connected to the Internet, hosting an auction in a mode where users view an item, and a price for an item, in a manner in

which users can place bids on items, and in which a current highest bid can be requested by another computer connected to the Internet; and hosting the auction in an interactive manner, in which the auction participants place real-time bids.

With regard to the recitation of first and second portions of the auction, the Examiner specifically notes that the instant claim uses the preamble transition “comprising”. As this is considered an open transition, the claim allows an interpretation wherein the entire auction is essentially practiced under one model, such as that described in eBay. That is, because the traditional eBay auction model teaches every limitation recited in the claim throughout a given auction, each limitation recited as being part of “a second portion” can be present in “a first portion”, and vice versa.

eBay does not explicitly disclose that the real time bids are seen automatically by other participants in the auction. Nevertheless, Brown teaches a system wherein a server automatically updates at least one screen being seen on at least one client to automatically show new bid amounts (*See* figures 2 and 9; column 6 line 53 – column 8 line 18; *see specifically* column 8 lines 12-18 – “Specific techniques of updating browser 29 in this manner are well known in the art.”). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the feature wherein the server automatically updates the bid amounts shown on at least one screen being seen on at least one client so that each client display is consistent with the current auction situation as taught by Brown.

b. Claim 24. Under the same rationale provided above, eBay further includes displaying information on client bidders who are currently bidding on the auction.

10. Claims 7, 23 and 24 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Odom in view of Alaia et al (US 6,199,050) (Alaia).

a. Claim 7. Odom clearly discloses a method of conducting an auction on the internet comprising on a computer **100** connected to the internet, first hosting a first portion of the auction in a mode where users view an item, and a price for the item (figure 2 – steps 210,215; see column 5 line 45 – column 6 line 27), and in which users can place bids on the items and users can request a current highest bid (see column 6 lines 28-32), as well as second hosting a second portion of the auction in an interactive manner, in which the auction participants place real time bids, which real time bids are seen automatically by other participants in the auction (see column 6 lines 55-58). Importantly, with regard to the recitation of first and second portions of the auction, the Examiner specifically notes that the instant claim uses the preamble transition “comprising”. As this is considered an open transition, the claim allows an interpretation wherein the entire auction is essentially practiced under one model, such as that described in Odom. That is, because the Odom auction model teaches every limitation recited in the claim throughout a given auction, each limitation recited as being part of “a second portion” can be present in “a first portion”, and vice versa.

In any event, assuming the claim required distinct first and second portions having different functionality, Alaia further teaches (see column 20 line 63 – column 22 line 51) that auctions are known have a first mode in which users place sealed bids on items (see column 22 lines 34-35) followed by a second on-line portion in which bidders interactively submit bids in real time in order for the seller (or the buyer, depending on

the nature of the auction) to allow bidder specific bid limitations to help achieve the optimal outcome for the seller (see column 24 lines 56-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow bidding during a first portion of an auction in order to more effectively achieve an optimal outcome as taught by Alaia.

b. Claim 23. The combination of Odom and Alaia set forth above includes the fact that users cannot view information about other bidders in the auction during said first portion of the auction (see Alaia column 20 line 63 – column 22 line 51 – pre-bids are sealed such that the other suppliers cannot view individual bid ceilings), but can view information about other bidders on the auction during said second part of the auction (see e.g. Alaia figure 8). This “information” may simply include the current real-time bids of the other bidders.

c. Claim 24. Alaia further teaches that said second portion comprises displaying information on client bidders who are currently bidding on the auction (see figure 8).

11. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over eBay in view of Ausubel and Hartman et al (US 5,960,411) (Hartman).

a. Claim 13. eBay discloses a method of automated auction bidding, comprising on a first computer connected to the internet, hosting an auction which allows a plurality of users at remote locations, that are remote from a location of said first computer, to bid on an item, where one of the plurality of users (e.g. “Joe” in the eBay example) has a highest bid which represents a maximum amount that the one user is willing to pay, and at least

one other of the plurality of users (e.g., “You” in the eBay example) can bid an amount that exceeds said highest bid; said first computer displaying a current winning amount, which is an amount that exceeds all the other bids on the item, but which may be less than, or the same as, said highest bid, depending on the relationship between said highest bid and said all other bids, and said first computer not displaying said highest bid (i.e., Joe’s maximum bid), and not displaying a minimum bid amount that will be required to exceed said highest bid.

eBay lacks explicit disclosure of enabling a quick bid whereby a user can automatically bid an amount which will exceed the highest bid.

Ausubel, however, teaches enabling a quick bid whereby a user can automatically bid an amount which will exceed the highest bid (see column 1 line 61 – column 3 line 67; see also example at column 10 line 39 – column 12 line 19 - in the example, the automated system containing bidder 1’s bidding rules automatically places bids high enough to win current bidding situations depending on the particular auction circumstances). Ausubel further discloses that the user may actively participate rather than rely on previously set bidding rules and would thereby be able to manually submit bids.

Still, however, neither one of eBay or Ausubel teaches or discloses that said quick bid is submitted via a single click. Nevertheless, Hartman teaches that single click order placing is well known in the art (see e.g. column 2 lines 55-60 and column 3 lines 30-67). Hartman employs the single click action within the context of placing an order over a communications network which is analogous to, if not exactly the same as, submitting a

quick bid over the internet in the context of an auction setting. The single click action of Hartman is made possible by way of previous entry of user identification information and assignment of a unique identifier to that user so that future submissions require only minimal effort (i.e. a single click) and prevent redundant transmission of sensitive information over the network.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the ability to submit a quick bid via the action of a single click as taught by Hartman.

b. Claim 14. Both eBay and Ausubel further disclose and/or teach a plurality of bids, some of which are known and others of which are secret, and wherein said quick bid only overcomes those bids which are known (see eBay in general and Ausubel column 1 line 61 – column 3 line 67; see also example at column 10 line 39 – column 12 line 19).

c. Claim 15. Ausubel further teaches said plurality of bids includes a plurality of bids, associated with times when those maximum bids can be made, and only those bids whose times have been reached are known (see column 1 line 61 – column 3 line 67; see also example at column 10 line 39 – column 12 line 19).

d. Claim 16. Ausubel further teaches enabling an action which allows determining both secret bids and non secret bids (see column 1 line 61 – column 3 line 67; see also example at column 10 line 39 – column 12 line 19 – in the example, the automated system performs queries which determine both secret and non-secret bids according to the rule profile).

Art Unit: 3679

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of eBay, Ausubel and Hartman, as applied above, further in view of Woolston (US 6,202,051).

Ausubel lacks explicit disclosure that said action includes an extra fee beyond that which would be charged for only non secret bids. Woolston, however, teaches that it is well known in the art to include fees charged for various actions in the auction setting (see specifically claims 29 and 30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an extra fee beyond that which would be charged for only non-secret bids since it is well known in online auctions to charge for various actions associated with an auction as taught by Woolston.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Odom, further in view of Hartman. Odom discloses a system comprising a server **100** running a program that displays information about an item to be auctioned (see column 6 lines 5-10), and accepts bids on said item (see column 6 lines 28-58), and keeps track of a maximum bid (column 6 lines 48-53); and a client **170** enabling and sending a bid to said server **100** which includes an amount of a bid (see column 6 lines 28-58 and element 220 of figure 2). Odom does not explicitly disclose that the client sends the bid to said server with a single click. Nevertheless, Hartman teaches that single click order placing is well known in the art (see e.g. column 2 lines 55-60 and column 3 lines 30-67). Hartman employs the single click action within the context of placing an order over a communications network which is analogous to, if not exactly the same as, submitting a bid over the internet in the context of an auction setting. The single click action of Hartman is made possible by way of previous entry of user identification information and assignment of a

Art Unit: 3679

unique identifier to that user so that future submissions require only minimal effort (i.e. a single click) and prevent redundant transmission of sensitive information over the network. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the ability to submit a bid via the action of a single click as taught by Hartman.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Odom and Hartman, as applied to claim 18 above, further in view of Brown, as applied above. The combination of Odom and Hartman lacks explicit disclosure of a system wherein said server automatically updates at least one screen being seen on at least one client to automatically show new bid amounts. Brown, however, clearly teaches a system wherein said server automatically updates at least one screen being seen on at least one client to automatically show new bid amounts (*See* figures 2 and 9; column 6 line 53 – column 8 line 18; *see specifically* column 8 lines 12-18 – “Specific techniques of updating browser 29 in this manner are well known in the art.”). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the feature wherein the server automatically updates the bid amounts shown on at least one screen being seen on at least one client so that the client is consistent with the current auction situation as taught by Brown.

15. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over eBay and Odom, further in view of Hartman. The combination of eBay and Odom, as applied to claim 25 above, does not explicitly include that the client sends the bid to said server with a single click. Nevertheless, Hartman teaches that single click order placing is well known in the art (see e.g.

column 2 lines 55-60 and column 3 lines 30-67). Hartman employs the single click action within the context of placing an order over a communications network which is analogous to, if not exactly the same as, submitting a bid over the internet in the context of an auction setting. The single click action of Hartman is made possible by way of previous entry of user identification information and assignment of a unique identifier to that user so that future submissions require only minimal effort (i.e. a single click) and prevent redundant transmission of sensitive information over the network. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the ability to submit a bid via the action of a single click as taught by Hartman in order to speed up the process of placing bids.

16. Claims 18, 20 and 21 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Ausubel in view of Hartman.

a. Claim 18. Ausubel discloses a system comprising a server running a program that displays information about an item to be auctioned and accepts bids on said item and keeps track of a maximum bid; and a client enabling and sending a bid to said server which includes an amount of a bid (see column 1 line 61 – column 3 line 67). Ausubel does not explicitly disclose that the client sends the bid to said server with a single click. Nevertheless, Hartman teaches that single click order placing is well known in the art (see e.g. column 2 lines 55-60 and column 3 lines 30-67). Hartman employs the single click action within the context of placing an order over a communications network which is analogous to, if not exactly the same as, submitting a bid over the internet in the context of an auction setting. The single click action of Hartman is made possible by

way of previous entry of user identification information and assignment of a unique identifier to that user so that future submissions require only minimal effort (i.e. a single click) and prevent redundant transmission of sensitive information over the network.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the ability to submit a bid via the action of a single click as taught by Hartman. See also *Response to Arguments* section below.

b. Claim 20. Ausubel discloses a system wherein said client allows sending a plurality of bids, to be executed at a plurality of times (see column 1 line 61 – column 3 line 67).

c. Claim 21. Ausubel further discloses an amount of said quick bid being displayed responsive to a specified action by the user (e.g., inputting the bid on the bid sheet displayed on user's system) (see column 1 line 61 – column 3 line 67).

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 2 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 09/780,248. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite substantially similar subject matter. Both claims recite bid validity determination at the local computer without contacting the computer hosting the auction. Claim 10 of the '248 application merely includes additional auction limitations which are considered to be old in the art, such as specific recitation of sending information between a server to a local computer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the limitations regarding bid validity determination at the local computer without contacting the computer hosting the auction as recited in claim 10 of the '248 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 09/780,248

in view of claim 8 of the '248 application. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite substantially similar subject matter. Claim 10 of the copending application, as applied above, includes local determination of bid validity as recited in instant claim 2, but lacks recitation of time-specific bid rules. Claim 8 of the '248 application, however, also recites user defined bid rules in an auction that are kept secret until a specified time. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to recite time-specific bidder rules that remain secret until the defined time.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. Claims 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 10-13 and 21 of copending Application No. 09/780,248, in view of Hartman and Brown. Claims 5, 10-13, and 21 of the '248 application recite the subject matter which is claimed in claims 18-20 of the instant application including displaying an item (see claim 12), allowing bids (see claim 12), keeping track of a maximum bid (claim 10), automatically updating client displays (see claim 11), and including time-dependent bid rules (claim 5). Claims 5, 10-13 and 21 do not, however, recite single click bid placement. Hartman, however, teaches that it is well known in the art to include a single click function for transmitting information over a network in order to simplify such process. Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to include single click functionality within the context of an auction based on the teachings of Hartman.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

21. Applicant's arguments are addressed to the claims *as amended* and are unpersuasive.
22. Applicant's arguments with respect to claims 2 and 25 have been considered but are moot in view of the new ground(s) of rejection which include eBay. The arguments are addressed in the detailed rejections set forth above.
23. In response to Applicant's arguments regarding claim 5, the Examiner notes that Ausubel teaches that bidding rules may vary widely depending on the instant bidder's preferences such that the details of each rule-controlled bid are kept secret until the parameters of the rule are met. The recited time-dependent placement of bids is believed to fall within the wide range of bidding rules taught by Ausubel.
24. In response to applicant's argument against the rejections of claims 7, 23 and 24, that Alaia and Odom are not properly combinable to teach the claimed limitations because Alaia teaches "a very different kind of auction", the Examiner respectfully disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any

Art Unit: 3679

one or all of the references. Rather, the test is what *the combined teachings of the references would have suggested to those of ordinary skill in the art*. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, given the open language of the claim (“comprising”), the auction model of Odom can be construed to read on an auction having two portions as described above. Furthermore, the teachings of Alaia suggest the advantages of conducting an auction in two parts wherein pre-bids can be submitted on an item in one portion and then real-time bids are taken later in an on-line portion to increase bid competition for the seller. The rejection is accordingly maintained.

25. In response to Applicant’s arguments regarding claim 13 and its dependents, specifically that Hartman is not properly combined with Ausubel (and now eBay), the Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, eBay and Ausubel teach that a remote user in an auction can automatically bid an amount that exceeds the highest bid of another user after viewing a current winning amount and without seeing the highest bid. The combination of eBay and Ausubel includes such bid being placed automatically based on a proxy bid and, thus, only lacks that the bid is placed by a single click. There, the highest bid amount is at least known by the auction system and, in this respect, is considered similar to a set price in any online purchase. One of ordinary skill in the art, in view of Hartman, would recognize that an auction winning quick bid would be placed with a single click to outbid the known highest bid amount. In view of the foregoing, the Examiner maintains the above rejections.

Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 9:00am- 6:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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November 29, 2004

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